

Remarks:

Applicant has studied the Office Action dated March 24, 2006, and has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 2, 4, 5, 6-8, 10-13, 15, 16, 18, 19, 21-23, 25-30 have been amended, claims 3, 9, 14, 17, 24, 31-34 have been canceled; and new claims 35-40 are added. No new matter has been added. Support for the new claims and the amendments are found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Drawings:

The Examiner objected to Figure 10. In response, Applicant has amended Figures 10, 11 and 12. New sheets including amended Figures 10, 11 and 12 are provided. Accordingly, it is respectfully submitted that the objection to the drawings should be withdrawn.

Abstract:

A new abstract limited to 150 words has been provided to replace the old abstract.

§101 Rejection(s):

The Examiner rejected all claims contending that if broadly interpreted the claims read over a human being. The claims have been amended to overcome the Examiner's rejection by reciting a non-living organism, particularly a toy that is configured to imitate human emotions and desires.

§112 Rejection(s):

Claims 1-34 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. As noted by the Examiner, the claims are a translation from a foreign language. The claims have been amended to more particularly recite the subject matter of the invention and should be now in compliance with the requirements of §112.

Allowable Subject Matter:

The Applicant wishes to thank the Examiner for finding claims 9-11, 17, 18, 24, 27 and 32 allowable if rewritten to overcome the above noted rejections and to include the elements of the base and intervening claims. As amended, claim 1 incorporates the elements of claim 9; claim 15 incorporates the elements of claim 17; and claim 19 incorporates the elements of claim 24. As such, independent claims 1, 15 and 19, and all their respective dependent claims 2, 4-8, 10-13 and 16, 18 and 20-23, 25-30 should be in condition for allowance.

§103 Rejection(s):

Claims 1-8, 12-16, 19-23, 25, 26, 28-31 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,153,160 (Dureau) in view of U.S. Patent No. 6,757,796 (Hofmann). The Examiner contends that it would have been obvious to combine the two references and that the resultant combination discloses the claimed invention. This rejection is respectfully traversed.

Dureau teaches an “interactive television system” configured to display an “animated character” that has an appearance that changes from healthy to unhealthy in accordance with the amount of time a TV program is watched. This is to encourage a viewer to view certain programs and to provide feed back to a broadcasting station (see Abstract; col. 7, lns. 5-20; col. 8, lns. 30-55). Hoffman is related to a method for “caching” data streamed during a broadcast over a communication network. The caching method is implemented to reduce the time delay experienced by a receiver before the streaming content is played (see Abstract; col. 1, lns. 35-55; col. 7, lns. 36-57).

Neither of the above two references either alone or in combination teach, suggest or disclose the claimed invention. Particularly, the references fail to disclose an adaptive toy system comprising (1) a body configured to convey desire information for at least one of (2) eating, (3) learning, and (4) playing; and (5) physically growing in response to receiving product information that satisfy the desire information; wherein a processing unit is connected to the

body for (6) downloading the product information from (7) a web server and providing the information to the adaptive toy, wherein the web server receives said desire information and stores advertising banners for goods of various companies; and (8) wherein the adaptive toy comprises a communication means for outputting the desire information directly to the web server .

The applicant has carefully reviewed the cited references. No portion of the cited references teach or suggest the above enumerated elements as recited in amended claim 1. The Examiner is invited to point out the sections of each reference that teach the above elements with more specificity. Furthermore, the Examiner has failed to point to any portion of the reference that provides a motivation to combine. MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings.” In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). Further, it is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since obviousness may not be established by hindsight reconstruction or conjecture, Applicant invites the Examiner to point out the alleged

motivation to combine with specificity, or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.¹

It is respectfully submitted that the cited prior art references cannot be combined to teach the claimed invention. Further, even if one is modified in accordance to the teaching of the other, the resultant modification would be an impractical or inoperable combination. For example, the Examiner has failed to provide any reason why a person of ordinary skill would be motivated to combine the teachings of Dureau directed to an animated character for promoting viewing of a certain TV program with the caching system disclosed by Hoffman.

That is, there is no indication in the Office Action how such combination is possible, as the two systems are independently complex and cannot be easily modified to work with each other. Further, even if the two systems can be combined, the resultant combination will not function to accomplish the downloading of information related to goods and services from the internet to the toy. Particularly, the system disclosed by Dureau does not operate to connect to the internet or download information from it. Therefore, the two references cannot be combined to teach the claimed invention.

For the above reasons, the invention as recited in the amended claim 1 is distinguishable over the references cited by the Examiner. Claim 15, 19 and new claim 35 substantially incorporate the discussed limitations of claim 1 and therefore claims 1, 15 and 19 and 35 should be in condition for allowance. Claims 2, 4-8, 10-13 and 16, 18-23, 25-30 and 36-40, respectively depending on claims 1, 15, 19 and 35 should also be in condition for allowance.

Furthermore, as noted earlier, the Examiner found claims 9-11, 17, 18, 24, 27 and 32 allowable if rewritten to overcome the above noted rejections and to include the elements of the

¹ "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

base and intervening claims. As amended, claim 1 incorporates the elements of claim 9; claim 15 incorporates the elements of claim 17; and claim 19 incorporates the elements of claim 24. As such, independent claims 1, 15 and 19, and all their respective dependent claims 2, 4-8, 10-13 and 16, 18 and 20-23, 25-30 should be in condition for allowance regardless of the Examiner's position toward the Applicant's arguments re 103 rejection.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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